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JJGJR.: 05-06

Paper No: __

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JUN 05 2006

OFFICE OF PETITIONS

In re Application of :
Gara : DECISION
Application No.: 09/779,038 :
Filing Date: 8 February, 2001 :
Attorney Docket No.: YOR920000192US1 :
:

This is a decision on the petition filed on 18 April, 2006, expressly as a petition to revive alleging unavoidable delay under 37 C.F.R. §1.137(a), and re-alleging a request for the withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**, and the petition under 37 C.F.R. §1.137(a) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a non-final Office action mailed on 9 August, 2005, with reply due absent extension of time on or before 9 November, 2005;
- the application went abandoned after midnight 9 November, 2005;
- in the original petition of 3 and 6 September, 2005, Petitioner indicated that he prepared (and may have transmitted via FAX) a reply before the due date, however, Petitioner did not receive a receipt confirmation from the Office, therefor, because Petitioner did not and could not make a showing as required to support a withdrawal of the holding of abandonment, and so the petition was dismissed on 13 February, 2006;

- with the instant petition, Petitioner re-asserts the request for withdrawal of the holding of abandonment (and even seeks to tie to his assertion the name of an attorney in the Office of Petitions as his authority for the grant of such a petition—an effort that is in vain if for no other reasons that: (a) the attorneys have no such authority, (b) the attorneys would not suggest they have such authority, and (c) the Rules of Practice clearly state that all practice before the office is in writing (see: 37 C.F.R. §1.2¹) and so no such verbal claim can be held to such authority), however, Petitioner does make a showing of unavoidable delay under 37 C.F.R. §1.137(a).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

¹ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷)

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁸ The commentary at MPEP §711.03(c) already has been outlined for Petitioner in a previous decision and need not be readdressed here.

Allegations as to
Unavoidable Delay

The regulatory requirements of a petition under 37 C.F.R. §1.137(a) are the petition and fee, reply, showing of unavoidable delay, and—where appropriate—a terminal disclaimer and fee.

Petitioner appears to have satisfied the applicable requirements.

CONCLUSION

The petition as considered under 37 C.F.R. §1.181 hereby is dismissed, however, the petition under 37 C.F.R. §1.137(a) is granted.

The instant application is released to Technology Center 2600 for further processing in due course.

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁸ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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